

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB

MARCH 19, 98

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Health Decisions, Inc.

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Serial No. 74/497,314

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Felicia J. Boyd of Faegre & Benson, attorney for applicant.<sup>1</sup>

John E. Michos, Trademark Examining Attorney, Law Office 105  
(Thomas G. Howell, Managing Attorney).

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Before Hanak, Hohein and Walters, Administrative Trademark  
Judges.

Opinion by Walters, Administrative Trademark Judge:

Health Decisions, Inc. has filed a service mark  
application to register on the Supplemental Register the  
mark DEMAND ANALYSIS for "investigation of health care  
utilization."<sup>2</sup>

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<sup>1</sup> Applicant's attorney was appointed by power of attorney filed after the filing of the briefs in this appeal.

<sup>2</sup> Serial No. 74/497,314, in International Class 35, initially filed on the Principal Register on March 7, 1994, based on use of the mark in commerce, alleging dates of first use and first use in commerce of May 28, 1993. During the examination of this application, applicant submitted substitute specimens in response to a requirement by the Examining Attorney, but applicant did not submit a declaration in support of the substitute specimens. While the Examining Attorney issued a requirement for such a declaration and no declaration was filed

This application was originally filed on the Principal Register. The Examining Attorney refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive of the services identified in the application, contending that DEMAND ANALYSIS is a type of marketing or business study. Subsequently, applicant amended its application, on February 2, 1995, to seek registration on the Supplemental Register.

The Examining Attorney has finally refused registration, under Section 23 of the Trademark Act, 15 U.S.C. 1091, on the ground that the subject matter of this application, as used in connection with the identified services, is generic and, thus, incapable of identifying applicant's services and distinguishing them from those of others.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

The specimen of record in this case is a two-page promotional letter that describes the company, its mission, and the services it offers. This letter describes applicant's mission as follows:

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prior to the issuance of a final refusal herein, the final refusal is silent on this point. However, applicant has since submitted the aforementioned declaration. Thus, we find no question regarding the declaration in support of the substitute specimens to require remand to the Examining Attorney or to be before us on this appeal.

[Applicant] provides organizations with demand management products and services. Demand management is a way to help individuals make rational health and medical choices that balance all the relevant factors, including benefits, risks and costs. Demand management results in better individual health and less costly medical care.

In this letter, under the heading "Comprehensive Data Analysis," applicant states:

[Applicant] provides the only analytical information package that can track both supply and demand in health care. It analyzes the use of medical care, workers' compensation, disability, sick leave, and factors in employee behavior (e.g., work-life satisfaction), to provide a complete profile of your organization's health.

The letter then identifies the three components of its "analytical information package" as DEMAND ANALYSIS™, PREDICTOR™ and SUPPLY ANALYSIS™. The letter describes the DEMAND ANALYSIS™ component as follows:

**Demand Analysis™** identifies the sources of demand, revealing patterns of use beyond cost categories. Demand Analysis™ provides clear, understandable indicators of each demand component and shows how each can be modified by health promotion, self-care, decision support, benefit plan redesign, and other interventions. Demand Analysis™ tracks how individuals use health care and the best intervention strategies to change their usage.

In support of his contention that DEMAND ANALYSIS is generic as used in connection with the identified services, the Examining Attorney has submitted excerpts of articles from the LEXIS/NEXIS Research Database.<sup>3</sup>

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<sup>3</sup> Applicant complained in its brief that the Examining Attorney had made of record only some of the excerpts found during his search of the

Following are some excerpts from the LEXIS/NEXIS evidence herein<sup>4</sup>:

Joint Committee on Taxation Staff Description on Methodology and Issues in the Revenue-Estimating Process - . . . If the Joint Committee staff were to attempt to incorporate such cyclical demand analysis in revenue estimates, it would present a biased picture of the effects of budget legislation on the Federal deficit . . . (*BNA, Daily Report for Executives*, January 24, 1995)

Papers sought for special issue of Journal of Business-to-Business Marketing - . . . may include, but will not be limited to, organizational buying behavior, buyer-seller dyad, relationship marketing, segmentation, demand analysis and forecasting, product, pricing, and placement management, as well as advertising and sales management. (*Marketing News*, January 16, 1995)

Consumer acceptance of a new experience good: a case study of vacuum packed fresh beef - Scan data are comparable to traditional data sets used in applied demand analysis. That is, they represent exchanges between suppliers and consumers. (*Journal of Consumer Affairs*, December 22, 1994)

One giant step into development; Loudon shopping center gives new prominence to grocery chain's realty subsidiary - "Based on our demand analysis,

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LEXIS/NEXIS database and applicant requested that it be given the complete results of the search. Upon remand by the Board, the Examining Attorney sent a copy of the complete results of his search to applicant, although he did not make these documents of record herein. Applicant was given an opportunity to submit a supplemental brief, but did not do so. Thus, while we do not have the additional excerpts before us, we will assume the excerpts of record are a representative sample of the results of the Examining Attorney's search, especially in view of the fact that applicant did not object or indicate otherwise after receiving the complete results of the Examining Attorney's search.

<sup>4</sup> We note that a few of the excerpts made of record are duplicative, are from non-U.S. publications, or are newswire stories. Those excerpts from non-U.S. sources are of minimal persuasive value as they do not necessarily show the use of the term as it would be viewed by U.S. purchasers. Similarly, newswire stories are of minimal persuasive value as they are directed primarily to editors and journalists, not to the consuming public.

we have enough commercially zoned land to accommodate us for at least 50 years," Richmond said.

Who's hot in job market - . . . strong growth in the business-service sectors, but lawyers, as usual, remain out of luck, according to a job demand analysis by the Colorado Department of Labor. (*Denver Business Journal*, October 28, 1994)

The following demand analysis is based on a survey of nearly 1,500 Canadian resort guests. (*Cornell Hotel & Restaurant Administration Quarterly*, October, 1994)

Any plan for short-term parking would have to be accompanied by a demand analysis. (*Business Journal - Portland*, September 30, 1994)

. . . presenting a variety of elements to be addressed in system planning, but a "complete understanding of the complex system in which tiltrotor aircraft would operate is lacking," the summary says. Planning guidelines and demand analysis need to be more specific and standardized, it concluded. (*Aviation Daily*, August 9, 1994)

Joint U.S.-Japanese study reveals difficulties of selling U.S. cars in Japan - . . . study, obtained by BNA, contains "major findings" in seven key areas - automobile certification standards, manufacturer-dealer relations, dealer behaviors and attitudes, social factors, prices, competitor analysis, and demand analysis. The Department of Commerce and the Ministry of International Trade and Industry are expected to release the full executive summary of the study. (*International Trade Reporter*, February 9, 1994)

The imperfect price-reversibility of world oil demand - The use of double-log functions in energy demand analysis has been criticized by Plourde and Ryan (1985), but there is no clearly superior alternative. (*Energy Journal*, October, 1993)

The following excerpt is the only credible excerpt in the record pertaining specifically to the health care field:

The scouts are out: Hospitals are stepping up physician recruitment because doctors bring patients and patients fill beds - . . . a medical staff development plan, a strategy for developing services over time, which legitimizes their needs. "We do supply and demand analysis by specialty, using national and local standards, taking into account how far people will travel to see a . . ." (*Executive Report*, April, 1993)

With respect to genericness, the Office has the burden of proving genericness by "clear evidence" thereof. *In re Merrill, Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be registered to refer to the genus (category or class) of goods in question. *In re Women's Publishing Co. Inc.*, 23 USPQ2d 1876, 1877 (TTAB 1992). Our primary reviewing court has set forth a two-step inquiry to determine whether a mark is generic: First, what is the genus (category or class) of goods at issue? Second, is the term sought to be registered understood by the relevant public primarily to refer to that genus (category or class) of goods? *H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986).

The Examining Attorney contends that the evidence of record establishes the following:

The genus or category of services at issue in this case consist of studies, investigations or analyses of the demand for or utilization of a particular product, commodity, or service. This

genus of services, which is individually and collectively referred to as demand analysis, is the proper name for any type of study, examination, or research on the sources or components of the demand for a particular product, resource, or service. These analyses share a common purpose or function, i.e., to identify, quantify, and/or specify the various components of demand. Applicant's investigation of health care utilization is a type of demand analysis for the health care industry.

The Examining Attorney contends that, although the area which is the subject of study may differ, the nature of the service known as DEMAND ANALYSIS is the same; that organizations whose business is to conduct research and analyze demand, regardless of the industry for whom they perform this service, describe this activity as DEMAND ANALYSIS; that health care is but one of the many fields in which the research study commonly known as DEMAND ANALYSIS is performed; and that the relevant public would understand applicant's identified services as falling within the genus or category of services identified as DEMAND ANALYSIS.

On the other hand, applicant maintains that the genus or category of services in question is "the investigation of health care utilization." In this regard, applicant maintains that the Examining Attorney has not met his burden of establishing either that DEMAND ANALYSIS is routinely or generically applied to such services, or that the relevant public would so understand the term.

We conclude from the record that the appropriate genus or category of services at issue is, as the Examining Attorney contends, a type of study that crosses industry sectors and analyzes demand for, and/or use of, a particular product or service. The record is replete with references to such a study as a DEMAND ANALYSIS. The articles excerpted by the Examining Attorney, which include both academic journals and trade publications, indicate that the relevant purchasing public for DEMAND ANALYSIS services includes businesses and organizations in any field where a business or organization needs information pertinent to purchaser or user demand for, or use of, the product or service offered.<sup>5</sup> Further, in view of this evidence, we believe that the relevant public understands the term DEMAND ANALYSIS as identifying a type of study as described herein.

Further, specifically in connection with applicant's identified services, businesses and organizations in the health care field, the relevant purchasers of applicant's services, will understand the term DEMAND ANALYSIS as identifying an "investigation of health care utilization." Based on the record before us, we conclude that DEMAND ANALYSIS is generic in connection with these services.

We are not convinced otherwise by applicant's contention that we should limit the genus or category of

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<sup>5</sup> As such, it is not significant that there is only one article using



services in this case to the health care industry. To be found generic, a term does not have to specifically name a narrow category as long as the goods or services are encompassed within the broad term. For example, in *In re Analog Devices*, 6 USPQ2d 1808 (TTAB 1988), *aff'd*, unpublished, 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989), the Board held that the term ANALOG DEVICES named a category or class of devices having analog capabilities and was generic for a number of products such as operational amplifiers, power supplies, converters, transducers, switches, etc., some of which were in the nature of analog devices. In response to applicant's argument that the term ANALOG DEVICES is a nebulous and vague one, the Board responded, at 1810:

However, while we readily concede that the category of products which the term "analog devices" names encompasses a wide range of products in a variety of fields, we do not believe this fact enables such a term to be exclusively appropriated by an entity for products, some of which fall within that category of goods. For example, while terms such as "digital devices," "computer hardware," "computer software," and "electronic devices," just to name a few, may be broad and even nebulous terms, nevertheless, these terms may not be exclusively appropriated but must be left for all to use in their ordinary generic sense.

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the term DEMAND ANALYSIS in relation to the health care industry.

*Decision:* The refusal to register on the Supplemental Register on the ground that the mark herein is generic in connection with the identified services is affirmed.

E. W. Hanak

G. D. Hohein

C. E. Walters  
Administrative Trademark Judges,  
Trademark Trial and Appeal Board